

## REMARKS

### INTRODUCTION:

In accordance with the following, no claims have been cancelled, amended or added herein. Claims 1-16 are pending in the present application. Claims 1, 4, 7, 11 and 16 are independent claims.

Reconsideration is respectfully requested.

### REJECTIONS UNDER 35 U.S.C. §112:

Claims 1-16 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. This rejection is traversed and reconsideration is requested.

The Office Action asserts that the present application fails to provide sufficient description of the term "host," so as to enable one skilled in the art to make or use the invention as claimed in claim 11. Claim 11 recites inter alia, "a signal inputting unit receiving R,G,B video signals from a host computer."

Applicant respectfully disagrees with this assertion at least because paragraph [0003] of the present application states:

"Generally, computer systems include a host and a display device."

Accordingly, Applicant asserts that based on paragraph [0003], and in light of the remainder of the present application, one skilled in the art would understand a host to potentially mean a non-display portion of a computer system. MPEP 2164.04 states the following regarding an enablement rejection:

In order to make an enablement rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. According to *In re Bowen*, 492 F.2d 859, 862-63, 181 USPQ 48, 51 (CCPA 1974), the minimal requirement is for the examiner to give reasons for the uncertainty of the enablement. This standard is applicable even when there is no evidence in the record of operability without undue experimentation beyond the disclosed embodiments (emphasis added).

The current Office Action has provided no reason as to why undue experimentation would be necessary and consequently the Office has failed to meet its initial burden for an

enablement rejection. Accordingly, it is respectfully requested the rejections under 35 USC 112, first paragraph be withdrawn.

Claims 1-15 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. This rejection is traversed and reconsideration is requested.

The Office Action then asserts the term "pixel level" is unclear. Applicant respectfully disagrees.

"[A] claim term that is not used or defined in the specification is not indefinite if the meaning of the claim term is discernible. *Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 USPQ2d 1996, 1999-2000 (Fed. Cir. 2004). The burden is on the Office to articulate a prima facie case as to why one skilled in the art would not understand what is claimed (MPEP 2173.02). If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, second paragraph, is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is "vague and indefinite" should be included in the Office action. *Id.*

Applicant points out that no such analysis has been provided in either of the most recent two Office Actions. Accordingly, it is respectfully requested these rejections be withdrawn.

#### REJECTION UNDER 35 USC 103:

Claims 1-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,644,325 (King) in view of U.S. Patent 5,809,366 (Yamakawa). All rejections are respectfully traversed.

Amended independent claim 1 recites at least the following features:

comparing the minimum pixel level value for the selected one R,G,  
or B component with a predetermined threshold value to determine  
whether an abnormal R,G, or B component is present, *the*  
*abnormal R,G, or B component being a component abnormally*  
*input due to malfunction of the host*

The current Office Action, similar to the previously filed Office Action, notes that King fails to suggest or disclose "comparing the minimum pixel level value for the selected one R, G, or B component with a predetermined threshold value and checking whether an abnormal one R, B, or B component includes an abnormal video signal. However, the Office Action proposes to modify King with Yamakawa, and asserts that Yamakawa compensates for the deficiencies of

King at col. 14, lines 35-38 "wherein RGB data is compared with previous RGB data and correction is based on the results of the comparison."

Applicant asserted in the Office Action filed August 9, 2007 that Yamakawa fails to suggest or disclose, either in the above-recited text or elsewhere, "the abnormal R,G, or B component being a component abnormally input due to malfunction of the host." However, the current response fails to even address Applicant's assertion. The current Office Action at page 10 merely states that the above-recited claim language is suggested by Yamakawa making a determination based on "whether the colors of these points deviate the expected result by more than an allowable range." The Office Action is silent with regard to the above-recited claim language and makes no attempt to specifically describe where Yamakawa suggests a host at all, let alone the "malfunction of the host." In fact, Yamakawa is deficient in at least two respects. First, Yamakawa would have no reason to suggest "a component abnormally input due to malfunction of the host" because Yamakawa is directed to the operation of a stand-alone scanner. Secondly, and as previously argued, Yamakawa fails to link the deviation to "the selected one R,G, or B component. Here also, the current Office Action has failed to specifically address Applicant's assertion.

As noted in at least MPEP 707.07(f), the Examiner is required to answer and address all traversals. This requirement is in addition to any repetition of a previously held position and is required to allow the applicant a chance to review the Examiner's position as to these arguments and to clarify the record for appeal.

Additionally and as further noted in MPEP 707.07(f), a failure of the Examiner to address the applicant's traversals can be deemed a failure to rebut these arguments so as to admit that the arguments have overcome the rejection. At the very least, the failure to address the applicant's traversals would render the Examiner's decision to again reject the claims arbitrary and capricious and invalid under the Administrative Procedures Act, 5 U.S.C. § 706, the standard under which such rejections are reviewed in view of *Dickinson v. Zurko*, 527 U.S. 150, 50 USPQ2d 1930 (1999).

As such, since the Examiner has not addressed the applicant's traversals presented in the August 9, 2007 Amendment, it is respectfully requested that the Examiner do so in the next Office Action.

Applicant also previously argued that Yamakawa fails to suggest or disclose "displaying on a screen a message indicating whether the selected one R,G, or B component includes a

video signal abnormally input due to the malfunction of the host" as recited in amended independent claim 1.

Applicant's argument in the August 7, 2007 Amendment reads:

When the colors described in Yamakawa deviate from the expected result, the user is simply warned to "execute the scanning again." Yamakawa fails to link the deviation to "the selected one R,G, or B component," nor does Yamakawa provide any indication of any "malfunction of the host."

In response, the current Office Action states on page 10:

Yamakawa teaches issuing of a warning, which corresponds to applicant's claimed message, in the cited portion above which application argues on the same page.

Upon reviewing the limited response provided in the Office Action it is clear that the current Office Action is unresponsive to Applicant's above-cited argument. For example, the Office Action fails to explain how Yamakawa's limited and completely different warning may disclose or suggest the very specific warning claimed above. Further, Applicant has asserted that Yamakawa fails to link the deviation to "the selected one R,G, or B component," and again, the current Office Action makes no attempt to rebut the assertion.

Based on the foregoing, Applicant again asserts that the current Office Action has not addressed the traversals presented in the August 9, 2007 Amendment, and it is respectfully requested that the next Office Action be a non-final Office Action addressing this response so that Applicant is afforded the opportunity to reply.

Further, Applicant submits that amended independent claim 1 patentably distinguishes over the cited reference, and should be allowable for at least the above-mentioned reasons. Since similar features recited by each of the independent claims 4, 7, 11, with potentially differing scope and breadth, are not taught or disclosed by the references, the rejection should be withdrawn and claims 4, 7, 11 allowed.

Claims 2-3, 5-10 and 12-15, which variously depend from independent claims 1, 4, 7, 11, should be allowable for at least the same reasons as claims 1, 4, 7, 11, as well as for the additional features recited therein.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.


Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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